

IBM CORPORATION  
INTELLECTUAL PROPERTY LAW DEPARTMENT  
11400 BURNET ROAD  
AUSTIN, TEXAS 78758  
FAX # 512

DATE: 12/22/04RECEIVED  
CENTRAL FAX CENTERNumber of Pages to Follow (including cover sheet) 5

DEC 22 2004

SEND TO: United States Patent Office

Examiner: P. J. SmithGroup Art Unit: 2176Tel No: 703-571-272-4101Fax #: 703-872-9306FROM: J. B. KRAFTTel No: 512-473-2307

THIS MESSAGE IS INTENDED ONLY FOR THE USE OF THE INDIVIDUAL OR ENTITY TO WHICH IT IS ADDRESSED, AND MAY CONTAIN INFORMATION THAT IS PRIVILEGED, CONFIDENTIAL AND EXEMPT FROM DISCLOSURE UNDER APPLICABLE LAW. IF THE READER OF THIS MESSAGE IS NOT THE INTENDED RECIPIENT, OR THE EMPLOYEE OR AGENT RESPONSIBLE FOR DELIVERING THE MESSAGE TO THE INTENDED RECIPIENT, YOU ARE HEREBY NOTIFIED THAT ANY DISSEMINATION, DISTRIBUTION OR COPYING OF THIS COMMUNICATION IS STRICTLY PROHIBITED. IF YOU HAVE RECEIVED THIS COMMUNICATION IN ERROR, PLEASE NOTIFY US IMMEDIATELY BY TELEPHONE AND RETURN THE ORIGINAL MESSAGE TO US AT THE ADDRESS ABOVE VIA THE U.S. POSTAL SERVICE. THANK YOU.

Docket No. AUS920000234US1 Serial No. 09/589,666 Atty: J. B. KRAFTApplicant: B. S. Baweja et al

<input type="checkbox"/> Transmittal Letter (2 copies)	<input type="checkbox"/> Certificate of Facsimile
<input type="checkbox"/> Preliminary Amendment	<input type="checkbox"/> Notice of Appeal
<input type="checkbox"/> Amendment AF	<input type="checkbox"/> Appeal Brief (3 copies)
<input type="checkbox"/> Ext. of Time	<input type="checkbox"/> Reply Brief
<input type="checkbox"/> IDS Statement	<input type="checkbox"/> Change of Address
<input checked="" type="checkbox"/> Other	

Response to Non-Compliance Notice

Deposit Acct. No.

Fees: Amendment \_\_\_\_\_ Notice of Appeal \_\_\_\_\_ Appeal Brief \_\_\_\_\_ Other \_\_\_\_\_

RECEIVED  
CENTRAL FAX CENTER  
DEC 22 2004

PATENT  
09/589,666

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: : Group Art Unit: 2176  
: Examiner: P. J. Smith  
Balijeet S. Baweja et al. : Intellectual Property  
Serial No: 09/589,666 : Law Department - 4054  
Filed: 06/08/2000 : International Business  
Title: DISTRIBUTING CONDENSED : Machines Corporation  
VERSIONS OF DISPLAYABLE : 11400 Burnet Road  
INFORMATION IN HYPERTEXT : Austin, Texas 78758  
MARKUP LANGUAGE DOCUMENTS :  
TRANSMITTED ON THE WORLD WIDE :  
WEB TO PERSONAL PALM-TYPE :  
DISPLAY COMPUTERS :  
Date: 12/22/04 :

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence including The present Amendment and an accompanying Transmittal letter is being transmitted via facsimile to USPTO, Group Art Unit 2176 at telephone number 703-872-9306, and to the attention of Examiner P. J. Smith on 12/22/04.

J.B. KRAFT

J.B. KRAFT  
Signature

12/22/04  
Date

RESPONSE TO NON-COMPLIANCE NOTICE

Commissioner for Patents  
P.O. Box 1450  
Alexandria VA 22313-1450

Sir:

In response to the Notice mailed December 7, 2004,

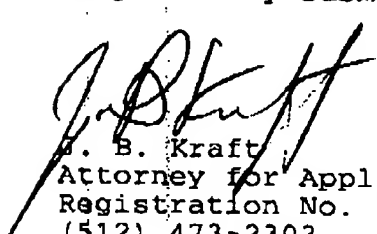
AUS920000234US1

1

PATENT  
09/589,666

attached are copies of pages 13 and 14 from the Response of  
July 16, 2004 which failed to properly transmit.

Respectfully submitted,

  
J. B. Kraft  
Attorney for Applicants  
Registration No. 19,226  
(512) 473-2303

ALL CORRESPONDENCE SHOULD BE DIRECTED TO:

Jeffrey S. LaBaw  
IPLaw Dept. - IMAD 4054  
IBM Corporation  
11400 Burnet Road  
Austin, Texas 78758

AUS920000234US1

2

Copy

PATENT  
09/589,666

the specific needs of users referred to as Advice Consumers of clients. This is carried out by a sophisticated system of intelligent servers which serve as agents for the advice consumers. In this extensive general disclosure which is not related to the present invention, the Examiner has extracted a segment at col 22, lines 15-22 which appears to only be pertinent if interpreted in light of Applicants' own teaching. There is a general statement of an E-mail message with alternative versions the selection of which is determined by the destination. When read in the light of Donoho's teaching, this only means that Donoho's interpretive servers can select the appropriate version suitable to the needs of the advice consumer. There still is no suggestion of the element of the present invention wherein there are means in the personal palm-type computer for directly accessing the second i.e. condensed version of the displayable data from the received markup language document.

Applicants submit that such a proposed combination of references is being made not with the requisite foresight of one skilled in the art, but rather with the hindsight obtained solely by the teaching of the present invention. This approach cannot be used to render Applicants' invention unpatentable.

What the Examiner has done is used Applicants' disclosure as a guideline, and the picked and combined elements from each of the kikinis and Donoho references based solely of Applicants' teaching.

"To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art references of record convey nor suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its

AUS920000234US1

3

*Copy*PATENT  
09/589,666

teacher." W. L. Gore, 721 F 2d at 1553, 220 USPQ,  
pp. 312-313.

"One cannot use hindsight reconstruction to  
pick and choose among isolated disclosures in the  
prior art to deprecate the claimed invention." In  
re Fine, 5 USPQ 2d 1596 (C.A.F.C.) 1988.

Accordingly, it is submitted that the suggestion for  
combining Kikinis with Donoho in the manner proposed by the  
Examiner could only come from Applicants' own teaching, and,  
thus, cannot form any basis for a combination of references.

Claims 4-8, 10-13, 15-18, 20, 22, and 24 include the  
further elements of a first and a second set of tags in each  
HTML document respectively identifying the two data set  
versions of the same content. Kikinis or Donoho contain  
nothing equivalent to such identifying tags.

In view of the foregoing, claims 4-18 and 23-34 are  
submitted to be in condition for allowance, and such  
allowance is respectfully requested.

Respectfully submitted,

*/s/ J.B. Kraft*

J. B. Kraft  
Attorney for Applicants  
Registration No. 19,226  
(512) 473-2303

ALL CORRESPONDENCE SHOULD BE DIRECTED TO:

Jeffrey S. LaBaw  
IPLaw Dept. - IMAD 4054  
IBM Corporation  
11400 Burnet Road  
Austin, Texas 78758

AUS920000234US1

4